



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,650	08/10/2001	Travis J. Parry	10012446-1	4432

7590

11/26/2003

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
----------	--------------

2626

DATE MAILED: 11/26/2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/925,650

Applicant(s)
Parry

Examiner
Mark Wallerson

Art Unit
2626



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 2626

Part III DETAILED ACTION

Notice to Applicant(s)

1. This application has been examined. Claims 1-24 are pending.

Double Patenting

2. Claims 1-24 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-19 of copending Application No. 09/925,649. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Receiving data at a printer; detecting a network address in the received data; requesting authorization to access the network (claims 10, 11, 12, 13 and 14 of Application 09/925,650); sending on the Internet or other network an access request for a document to the network address; retrieving the document from the network address and printing the document.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Art Unit: 2626

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 17, 18, 22, and 23 are rejected under 35 U.S.C. 102(e)

as being anticipated by Tabata et al (Tabata) (U. S. 6,537,324).

With respect to claims 1, 5, and 22, Tabata discloses a printing method comprising receiving data at a printer (470B) (column 23, lines 56-63); determining whether an external network option is enabled (which reads on transferring the address to a file server) (column 24, lines 14-17); detecting if a network address is in the received data (column 23, line 56 to column 24, line 17); sending on the Internet an access request for a document to the network address (column 24, lines 18-23); retrieving the document (column 24, lines 24-25), and printing the document (column 24, lines 36-38).

With respect to claim 2, Tabata discloses the address is a URL (column 12, lines 43-47).

With regard to claims 3 17, 18, and 23, Tabata discloses detecting a barcode (column 6, lines 26-37).

Art Unit: 2626

With regard to claim 4, Tabata discloses printing the untranslated barcode (column 26, lines 32-46).

With respect to claims 6 and 7, Tabata discloses presenting a display to the user for enabling the network access option (column 5, lines 51-58).

With regard to claims 8, 9, and 24, Tabata discloses enabling the URL from a control panel at the printer (the integration of the printer, scanner and terminal equipment) (column 27, lines 9-33).

With respect to claim 10, the control panel is at a remote location (10).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11, 12, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata in view of Russell et al (Russell) (U. S. 6,375,078).

With respect to claims 11, 12, 13, and 14, Tabata differs from claims 11, 12, 13, and 14 in that he does not clearly disclose sending a user name or password to the remote administration location. Russell discloses a method for retrieving information from a network source wherein authorization for access to the network occurs by requiring the user to enter an access code

Art Unit: 2626

(column 19, line 55 to column 20, line 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata wherein a user name or password is sent to the remote administration location. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata by the teaching of Russell in order to improve the security of the system.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata in view of Wolff (U. S. 5,848,413).

With respect to claims 15 and 16, Tabata differs from claims 15 and 16 in that he does not clearly disclose receiving E-mail containing the data. Wolff discloses a method for retrieving data from the Internet wherein the data is retrieved via E-mail (column 10, lines 37-48). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata wherein the data is received by E-mail. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata by the teaching of Wolff in order to allow for simplified access to the Internet.

Art Unit: 2626

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 19, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Tabata in view of Wolff.

With respect to claims 19, 20, and 21, Tabata differs from claims 19, 20, and 21 in that he does not clearly disclose printing the document within another document and identifying the contents of the documents. Wolff discloses printing the document within another document and identifying the contents of the documents (column 6, lines 29-37 and lines 58-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata to print the document within another document and identify the contents of the documents. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tabata by the teaching of Wolff in order to allow greater user control of the formatting of the retrieved documents.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent 5,873,077 is cited as it discloses a method for searching for and retrieving documents using a fax machine.

Art Unit: 2626

U. S. Patent 6,434,561 is cited as it discloses a method for accessing electronic resources via machine readable data on documents.

U. S. Patent 6,609,843 is cited as it discloses resource acquisition with a printing device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two

2121 Crystal Drive

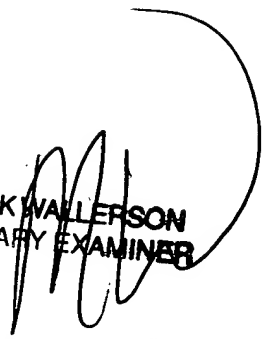
Arlington, VA.

Sixth Floor (Receptionist)

Application/Control Number: 09/925,650

Page 8

Art Unit: 2626


MARK WALLERSON
PRIMARY EXAMINER

MARK WALLERSON